



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,545	03/09/2000	Dale G. Swan	9896.145.0	2248

23552 7590 10/07/2002

MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER
----------

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

File copy

# **Advisory Action**

Application No.  
**09/521,545**

Applicant(s)  
**Swan et al.**

Examiner  
**Bennett Celsa**

Art Unit  
**1639**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 30, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-9 and 29-32
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See attachment

Art Unit: 1639

**Advisory Action Cont.**

**NOTE:** the location of this application is now **ART UNIT 1639**.

I. Applicant's arguments regarding the prior art of record, were considered but deemed nonpersuasive for the reasons already of record.

As already discussed applicant's claims are product-by-process claims in which prior art products anticipate (e.g. Kalal et al.) epoxy containing copolymers presently claimed.

Additionally, as pointed out in the rejection, the Kalal reference additionally teaches the intended use language (e.g. "for attaching ...") presently claimed. Nor has applicant provided any arguments or evidence of record as to how their process results in compounds/compositions that distinguishes of prior art compositions e.g. by possessing unexpectedly superior properties.

Examiner arguments addressing applicant's traversal regarding obviousness rejections are already of record.

II. Applicant's arguments regarding the indefinite rejection of claim 30 for the term "hydrophilic" were considered but deemed nonpersuasive for the following reasons.

Applicant argues that "terms of degree" are not necessarily indefinite (e.g. citing *Seattle Box Co. v. Industrial Crating & Packaging, Inc.*). Additionally, applicant argues that the specification definition of the term "hydrophilic" (e.g. page 12, lines 18-20) and the "examples of hydrophilic monomers as standards" render the term "hydrophilic" definite.

Art Unit: 1639

This is not persuasive since the specification does not provide a definition for "hydrophilic" (as per monomers or polymers as in claim 30); nor do the examples provide any means of evaluating what qualifies a monomer or polymer as being "hydrophilic".

The specification on page 12 referred to by applicant doesn't provide a clear definition but merely provides a broad description of a "hydrophilic polymer" e.g. as "bearing a desired average of number of photogroups and epoxides groups per average unit length or molecular weight, the combination dependent upon the reagent selected" and "[T]he diluent comonomers are preferably hydrophilic (e.g., water soluble), with acrylamide and vinylpyrrolidine being particularly preferred". Accordingly, the examples (e.g. acrylamide/vinylpyrrolidine) do not provide a means for measuring and/or a standard for determining degree with respect to:

- a. a desired average of number of photogroups and epoxides groups per average unit length or molecular weight dependent upon the reagent selected OR
- b. water solubility that is necessary to qualify a monomer/polymer as sufficiently "hydrophilic" within the scope of the present claims so as to indicate what would or what would not infringe.

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 163927)  
October 7, 2002

BENNETT CELSA  
PRIMARY EXAMINER

